

**Application No. 09/755,635****Atty Docket: BLFR 1001-1****REMARKS**

Applicants respectfully request reconsideration of the restriction requirement since it is inappropriate under the circumstances of the present application.

The Examiner has identified five claim groups, each group corresponding to a single independent claim. Applicants feel that the Examiner has been too literal in determining that software features could be used independently of one another, are patentably distinct, and that the boilerplate recitation of a SERIOUS burden resulting from five separate searches is not persuasive. Applicants suggest that no more than two groups should be established for purposes of restriction.

If the test for restricting features of software were literally independent operability, then three ways of deleting a character using word processing software would be divided into three patent applications: backspacing can be implemented separately from a delete key and separately from overtyping text to be replaced. That extreme degree of restriction is not authorized by statute or PTO policy.

The MPEP most strongly discourages an Examiner from proposing to divide applications where the claims have such trivial differences:

**802.01 Meaning of "Independent" and "Distinct"**

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application.

\* \* \*

**INDEPENDENT**

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

**DISTINCT**

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE

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(novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

\* \* \*

#### **CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§ 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) -§ 806.04(l), § 808.01(a), and § 808.02).

\* \* \*

#### **803.01 Review by Examiner with at Least Partial Signatory Authority**

Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section of the statute apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, IT STILL REMAINS IMPORTANT FROM THE STAND-POINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.

One of the criteria that the Examiner must apply is that the claims are patentably distinct, that is, none of the claims are obvious from one another. Applicants ask whether the Examiner is prepared to say that claims 1 and 63 (and 25) are patentably distinct. The difference between the two claims appears in the first element in just three letters: claim 1 includes "associating respective selling in-dates with a good"; claim 63 includes identical limitations applied to "selling out-dates". If the Examiner asserts that these claims are patentably distinct and nonobvious from one another, that will strengthen the patent considerably and may justify acquiescing in the restriction. However, the Examiner has not yet made the unequivocal statement that claims 1 and 63 (and 25) are, in the Examiner's opinion, patentably distinct and all unobvious from one another. Without that determination, restriction is improper.

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The other criteria that the Examiner must apply is a SERIOUS burden on the Examiner if restriction is not required. Applicants do not see how the difference between "in-" and "out-" date in claims 1 and 63 would lead to different searches or assignment to different subclasses. An efficient and prudent examiner would not conduct independent searches for claims 1 and 63. Nor would claim 25, which covers presentation in-dates and presentation out-dates on particular fixtures, be searched independently of claims 1 and 63. The recitation that the searches required for claims 1 and 63 are not required for claim 25 is not persuasive in any practical sense. The overlap is readily apparent and defeats any claim of a SERIOUS burden.

If the Examiner persists in asserting that some restriction should be imposed, Applicants submit that Groups I, II and IV (in, out and presentation dates) should be consolidated and Groups III and V (under and over stocks) should be consolidated.

**Provisional Election**


Should the Examiner persist in her claim-by-claim restriction requirement, Applicants provisionally elect to prosecute the claims identified by the Examiner as Group II, independent claim 25 and dependent claims 26-46. If it becomes apparent that the search for Group II overlaps with searches for Groups I or IV, Applicants reserve the right to revisit any restriction.

**CONCLUSION**

Applicants respectfully submit that the pending claims are in condition for allowance and solicit acceptance of the claims.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone (415) 902-6112 most other times.

Respectfully submitted,

  
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